

IA 1502.01A US  
USSN: 09/296,202

PATENT  
Art Group: 3621

### **REMARKS**

Claims 1-19 are pending in the present application.

This Amendment is in response to the Office Action mailed May 8, 2003. In the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 102 (a). Applicant has amended claims 1-19. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Applicant kindly requests that the Examiner sign and initial a copy of the Forms PTO-1449 as filed on November 14, 2000, March 9, 2001, June 4, 2002 and January 10, 2003. Pursuant to a telephone conference with Examiner Sherr, copies of these PTO -1449s were submitted via facsimile on May 20, 2003. Applicant further requests that a signed and initialed copy of the PTO-1449 forms be returned to Applicant's mailing address to complete Applicant's records.

### **REJECTIONS UNDER 35 U.S.C. § 102(a)**

In the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. US 5,938,730 issued to Tobita. ("Tobita").

Tobita discloses method of managing a software, having a product code, by transmitted data on a network. When a use-charge of the software is paid, the software provider is informed of the product code. A key code of the software is then sent to the user's computer and the user is now able to use the software for a predetermined period of time (Tobita, Col. 4 (lines 7-40)). Unlike the present

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invention, Tobita does not disclose tracking an electronic storage medium while the medium being shipped between various entities using a tracking identifier.

To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131).

Since Tobita does not teach nor suggest tracking the electronic storage medium while being shipped between various entities using the tracking identifier. Therefore, Applicant respectfully requests that rejection be withdrawn.

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### CONCLUSION

In view of the amendments and remarks made above, It is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

FAX RECEIVED


Respectfully submitted,

JUL 11 2003

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Dated: June 26, 2003

  
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CERTIFICATE OF FACSIMILE TRANSMISSION	
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No.	
(703) 305 -7687	on June 26, 2003
Susan Myers (Type or print name)	 (Signature)

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